

REMARKS

This is a full and timely response to the outstanding final Office Action mailed July 26, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 1-6, 9-11, 13, 17-23, and 25-31

Claims 1-6, 9-11, 13, 17-23, and 25-31 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmid (U.S. Pat. No. 5,659,164) in view of Walsh (U.S. Pat. No. 5,496,071) and Ellis (U.S. Pat. No. 6,218,964). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art does not teach or suggest all of the claim limitations, and there is no suggestion or motivation in the prior art to modify the references to include those limitations.

1. The Schmid Disclosure

Schmid discloses a method for automatically creating and routing scanned documents. Schmid, Patent Title. As is summarized by Schmid:

Specifically, the method of the invention involves the use of a cover page which contains both machine and human-readable information, but with machine-readable code information containing the network address or identifier for the individual to whom the documents should be assigned or routed, as well as settings for the scanner and/or additional operations to be performed, such as OCR (optical character recognition), and the like--all without the need for operator control or intervention. Stacks of paper containing printed information . . . are placed into the ADF at random for scanning. The only requirement is that each logical set of pages (normally a document) needs to be preceded by such a cover page containing the particular machine-readable information above specified. If it is such a cover page, it automatically extracts the machine-readable information from the digitized page, recognizes it and records the information. When a new cover page is detected or when the scanner ADF is empty, then the previous page becomes the last page of the document and all pages of the document are electronically "stapled" into a single identifiable entity

which can be routed as specified by the machine-readable code and stored.

[Schmid, column 2, lines 14-37]

Accordingly, Schmid's system scans documents that include a cover sheet that comprises machine-readable information that: (i) identifies the beginning of the document, and (ii) specifies to whom the document should be routed and what processing of the document should be performed.

2. The Walsh Disclosure

Walsh discloses a method of providing article identity on printed works. Walsh, Patent Title. As is described by Walsh, printed works, such as periodical articles (Walsh, column 2, lines 3-8), can be provided with a bar code that comprises various information, such as author name and publisher name (Walsh, column 5, lines 40-55).

3. The Ellis Disclosure

Ellis discloses a digital reading pen. Ellis, Patent Title. As is described by Ellis, the reading pen 10 comprises a scanner 22 for scanning printed information. Ellis, column 2, lines 42-48. The reading pen further comprises "outputs" to other computers to which scanned information may be downloaded and printed. Ellis, column 4, lines 41-49.

4. Applicant's Claims

Applicant's claims describe various methods, systems, and devices that are not rendered obvious by the applied references. Applicant discusses the various claim groups in the following.

(a) Claims 1-6, 9, and 25-27

Independent claim 1 provides as follows (emphasis added):

1. A method for collecting information when conducting research, comprising:

electronically capturing content with a handheld scanning device;

separately electronically capturing source information pertinent to the source of the captured content using the handheld scanning device;

associating the content and the source information on the handheld scanning device; and

transmitting the associated content and source information from the handheld scanning device to another device for manipulation.

As an initial matter, Applicant respectfully objects to the combination of the applied references. In particular, Applicant asserts that there is no proper motivation to combine the references and modify their disclosed inventions in the manner suggested by the Examiner.

As is described above, Schmid's system scans documents that include a cover sheet that comprises machine-readable information that: (i) identifies the beginning of the document, and (ii) specifies to whom the document should be routed and what processing of the document should be performed. With this scanning, separate documents can be identified by the scanner, and those documents can be sent to intended recipients. There is no reason why a person having ordinary skill in the art would think to combine Walsh's bar code information to Schmid's documents at least because the Schmid system is only concerned with distinguishing between documents and sending

them to the intended recipients. In other words, Schmid is not concerned about identifying an author or publisher name associated with the documents. The reason for this appears to be simple: Schmid's system is not a research tool but instead is a tool that is useful in digitizing hard copy documents in an office setting (see Schmid, column 1, lines 23-28). Therefore, a person having ordinary skill in the art would not be motivated to put bar codes that identify author and publisher name on Schmid's documents, or incorporate components into the Schmid's scanner that read and identify that information.

Applicant further respectfully objects to the combination of the Ellis reference with the Schmid reference. In particular, although it is easy to argue that it would have been "obvious" to incorporate all of the functionalities of Schmid's desktop scanner into Ellis' digitizing pen, there must be a teaching in the prior art that suggests and enables such a modification. In other words, the Examiner is suggesting, without any proper basis, that it would have been obvious to simply substitute Schmid's desktop scanner for Ellis' digitizing pen. Clearly, such an assumption is unwarranted.

Given the lack of a suggestion or motivation contained in the prior art for the modifications proposed in the Office Action, it appears clear that the only suggestion or motivation comes from Applicant's own disclosure. As is well established in the law, such hindsight to the Applicant's own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

As a related point, Applicant objects to the manner in which the Examiner picks and chooses, in hindsight to Applicant's disclosure, elements from the prior art

in an attempt to account for each of Applicant's claim limitations. Under the Examiner's analysis, each limitation of Applicant's claims is being considered independent of the other limitations. Such an approach is improper given that it treats Applicant's claims in a piecemeal fashion such that each limitation is evaluated in a vacuum. As is well established in the law, the Examiner must instead consider the claims as a whole. *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987) (In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed"). Therefore, for example, it is improper to combine Walsh's bar codes and Ellis' disclosure of a digitizing pen with Schmid's system without a teaching or suggestion in the prior art to do so.

Beyond the lack of motivation to combine the references and modify the Schmid system as suggested by the Examiner, the rejection fails to render Applicant's claims obvious because the references fail to teach or suggest all claim limitations. For example, none of the references teach or suggest electronically capturing content *and* "separately electronically capturing source information pertinent to the source of the captured content". Contrary to that argued in the Office Action, Schmid does not teach or suggest "separately electronically capturing source information". Specifically, Schmid only captures document content *along with* content. This is apparent from Figure 1 which shows a cover page that includes machine readable information *and* "human readable information." Therefore, there is no "separate" capture of information.

Furthermore, Schmid does not teach or suggest "associating the content and the source information on the handheld scanning device". Specifically, since the

machine readable information on the cover pages in Schmid's system only identify to whom the document is to be sent and what type of processing to perform on the document, no "association" of content and source information is performed.

Applicant's dependent claims contain further limitations that are not taught or suggested by the applied references. Regarding claim 3, the references do not teach or suggest "capturing the content and source information with separate text and data code scan heads". Applicant notes in response to the Examiner's argument that the MRI code reader R described by Schmid in column 4, lines 28-35 is *not* a separate scan head. Instead, the reader R is a component of the scanner that recognizes and interprets machine readable information scanned by the scanner along with the document content.

Regarding claim 4, none of the references teach or suggest "scanning a bar code of the source separate from scanning content within the source". Applicant refers to the discussion of "separately" limitation of claim 1 above.

Regarding claim 6, none of the references teach or suggest source information that comprises "information that can be used to retrieve bibliographic information pertinent to the source". Contrary to that argued in the Office Action, Walsh column 3, lines 5-11 describe information comprised by the document or bar code, not information that can be used to "retrieve" bibliographic information.

Regarding claims 25 and 26, none of the references teach or suggest "selecting a first mode associated with source information capture prior to capturing source information" or "selecting a second mode associated with content location information capture prior to capturing the content location information". Applicant specifically notes that Ellis does *not* teach these functionalities. Moreover, such functionalities would not have been obvious in view of the references given that, as is noted above, none of the references contemplate separate scanning of particular types of information.

Regarding claim 26, none of the references teach or suggest “adding associated metadata tags to the content and the source information on the handheld scanning device”.

(b) Claim 10

Independent claim 10 provides as follows (emphasis added):

10. A handheld scanning device for recording information when conducting research, comprising:

means for electronically capturing content;

means for separately electronically capturing source information pertinent to the source of the captured content;

means for associating the content and the source information on the device; and

means for transmitting the associated content and source information to another device for manipulation.

As an initial matter, Applicant incorporates the comments regarding the lack of motivation to combine and modify provided above in relation to claim 1. Those comments apply equally to claim 10.

Turning to the limitations of claim 10, the references do not teach or suggest “means for separately electronically capturing source information pertinent to the source of the captured content” or “means for associating the content and the source information on the device” for reasons described in the foregoing.

(c) **Claim 11, 13, and 17-18**

Independent claim 11 provides as follows (emphasis added):

11. A method for using captured information, comprising:
 - receiving a transmission from a handheld scanning device, the transmission including content and ***associated source information pertinent to the source of the content in electronic form;***
 - receiving from the handheld scanning device an indication that the content and the source information are associated with each other;
 - reconfiguring the content and associated source information for use in a user application; and

automatically creating at least one source acknowledgement in the user application using the received association indication.

As an initial matter, Applicant incorporates the comments regarding the lack of motivation to combine and modify provided above in relation to claim 1. Those comments apply equally to claim 11.

Regarding the limitations of claim 11, the references do not teach or suggest receiving a transmission from a handheld scanning device, the transmission including content and “associated source information pertinent to the source of the content in electronic form”. As is noted above in relation to claim 1, Schmid’s scanner does not transmit, and therefore Schmid’s computer does not receive, any information pertinent to the “source of the content”. Walsh’s mere teaching of providing a bar code that identifies an author and publisher name does not remedy this deficiency of the Schmid disclosure.

Furthermore, the references do not teach or suggest “automatically creating at least one source acknowledgement in the user application using the received

association indication". Contrary to that argued in the Office Action, Walsh says *nothing* of "automatically creating at least one source acknowledgement".

Regarding dependent claims 13 and 17, none of the references teach or suggest automatic creation of a "bibliography" or "retrieving bibliographic information".

(d) Claim 19

Independent claim 19 provides as follows (emphasis added):

19. A system for using captured information, comprising:

means for receiving a transmission from a handheld scanning device, the transmission including content and *associated source information pertinent to the source of the content in electronic form*;

means for receiving from the handheld scanning device an indication that the content and the source information are associated with each other;

means for reconfiguring the content and associated source information for use in a user application; and

means for automatically creating at least one source acknowledgement in the user application using the received association indication.

As an initial matter, Applicant incorporates the comments regarding the lack of motivation to combine and modify provided above in relation to claim 1. Those comments apply equally to claim 19.

Regarding the limitations of claim 19, none of the references teach "means for receiving a transmission from a handheld scanning device, the transmission including content and associated source information pertinent to the source of the content in electronic form" or "means for automatically creating at least one source

acknowledgement in the user application using the received association indication” for reasons described in the foregoing.

(e) Claims 20-23 and 28-31

Independent claim 20 provides as follows (emphasis added):

20. A *handheld scanning device*, comprising:

a housing configured as a pen;

a scan head that is adapted to capture bibliographic source information in a first mode and separately capture content from the source in a second mode; and

memory including an information association module that is configured to associate the captured content with the captured source information prior to transmission of the content and the source information to another device.

As an initial matter, Applicant incorporates the comments regarding the lack of motivation to combine and modify provided above in relation to claim 1. Those comments apply equally to claim 20.

Regarding the limitations of claim 20, the references do not teach or suggest a handheld scanning device comprising “a scan head that is adapted to capture bibliographic source information in a first mode and separately capture content from the source in a second mode”. First, there is no basis for the argument that it would have been obvious to incorporate such modes into a handheld scanning device. Ellis only teaches a digitizing pen for scanning content. Nowhere does Ellis or the other references provide motivation or enablement for incorporating a content scanning mode and a source information scanning mode into Ellis’ pen. Second, as is noted

above, none of the references teach or suggest “separately” capturing content and source information.

Furthermore, the references do not teach or suggest “an information association module that is configured to associate the captured content with the captured source information” for reasons described in the foregoing.

Regarding dependent claim 21, none of the references teach or suggest a handheld scanning device comprising “two separate scan heads, one provided at each end of the device”. Simply stated, there is no support for such components in the prior art.

Regarding claim 28, none of the references teach or suggest a function key that can be used to “switch the handheld scanning device between the first and second modes”, the first and second modes pertaining to source information capture and content capture. As is noted above, none of the references teach or suggest separate capture of source information and content.

Regarding claim 29, none of the references teach or suggest an information association module “configured to add associated metadata tags to the content and the source information”.

Regarding claim 30, none of the references teach or suggest separately capturing “content location information in a third mode”. As is noted above, the references do not even teach separate first and second modes.

B. Rejection of Claims 7, 8, and 14-16

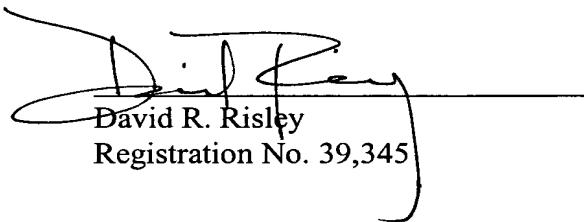
Claims 7, 8, and 14-16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmid in view of Walsh, Ellis, and Nurse (U.S. Pat. No. 5,097,418). Applicant respectfully traverses this rejection.

As is identified above in reference to independent claims 1 and 11, Schmid, Walsh, and Ellis are not properly combinable and fail to teach explicit limitations of Applicant's claims. In that Nurse does not remedy the deficiencies of those other references, Applicant respectfully submits that claims 7, 8, and 14-16, which depend from claims 1 and 11, are allowable over the Schmid/Walsh/Ellis/Nurse combination for at least the same reasons that claims 1 and 11 are allowable over Schmid/Walsh/Ellis.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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9-14-05
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Signature